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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,709	08/22/2001	Charles A. Morris	1533.0520001	6249

26111 7590 12/30/2003

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
PULLIAM, AMY E	
ART UNIT	**PAPER NUMBER**
1615	

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/933,709	MORRIS ET AL.	
	Examiner	Art Unit	
	Amy E Pulliam	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 September 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Receipt of Papers

Receipt is acknowledged of the Request for Extension of Time, the Amendment D, and the Declaration, all received by the Office September 17, 2003.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 18-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,603,143 to Schmidt (US '143).

US '143 discloses vitamin active powders which are more free-flowing and stable than conventional vitamin powders. US '143 teaches that the composition comprises at least one fat-soluble vitamin material and a silicon containing material (c 1, l 38-45). US '143 also teaches that the vitamin be vitamin E, and further explains that vitamin E comprises a group of natural substances known as tocopherols (c 2, l 55-57). It is the position of the examiner that this disclosure reads on applicant's claim to mixed tocopherols. Furthermore, US '143 teaches that the silicon dioxide used in their composition has a density of around 0.2 g/cc (which is equivalent to 12.5 lbs./cu. ft.), and a particle size which passes through a 100 mesh sieve (c 3-4, table 1). (A 100 mesh sieve allows only particles which are smaller than 150 microns to pass through).

US '143 does not teach the specific particle size for the silica, as claimed by applicant. However, US '143 does teach that the particles are smaller than 150 microns. It is the position of the examiner that the determination of a particular particle sizes from within a broad range is within the skill of the ordinary worker as part of normal optimization. Additionally, US '143 does not teach the surface area of the silica. However, the burden is shifted to applicant to show that the silica disclosed by US '143 does not possess the same characteristics as the silica claimed by applicant. Lastly, US '143 does not specifically use the language mixed tocopherols in describing the vitamin to be used in their composition. However, as discussed in the anticipatory rejection, US '143 does teach that vitamin E is a group of natural substances known as tocopherol, and it further teaches that vitamin E can be used as the vitamin of the disclosed composition. Applicant admits in his own specification that vitamin E is a mixture of different molecular species, including d-alpha, d-beta, d-gamma, and d-delta, which vary based on the natural variation of the oil (applicant's specification, p 3, l 24-27).

Lastly, the reference does not specifically discuss stability. However, it is the position of the examiner that absent evidence to the contrary, the formulation must provide appropriate stability, or it would be useless for its intended purpose. Furthermore, The Office does not have the facilities for examining and comparing applicant's product with the product of the prior art in order to establish that the product of the prior art does not possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed products are functionally different than those taught by the prior art and to establish patentable differences. *See Ex parte Phillips*, 28

U.S.P.Q.2d 1302, 1303 (PTO Bd. Pat. App. & Int. 1993), *Ex parte Gray*, 10 USPQ2d 1922, 1923 (PTO Bd. Pat. App. & Int.) and *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977).

Therefore, it is the position of the examiner that based upon applicant's own admission, the disclosure in US '143 teaching the use of vitamin E suggests the limitations of the instant claims. One of ordinary skill in the art would have been motivated to make a vitamin composition comprising vitamin E and silica. The expected result would be a free-flowing, fat-soluble vitamin powder with improved stability. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicants' arguments have been fully considered but are not found persuasive. Applicants argue that the cited reference does not teach the claimed particle size. Applicants assert that the use of silica that is 40 to 50 microns in length is critical to obtain the desired properties of the claimed invention, and Applicants have filed a declaration stating this. Applicants assert that the declaration provides support for this assertion because the silica outside the 40 to 50 micron size range produced vitamin powders which were chunky and gritty instead of free flowing. The examiner points out to Applicant that the data presented in the declaration does not clearly support the claimed range of 40 to 50 microns. The data provided shows several particle sizes up to 16 microns, one data set at 50 microns, and one data set at 100 microns. This data does not conclusively demonstrate that the unexpected results occur within 40 and 50 microns. The data in the declaration is not commensurate in scope with the claims,

and therefore is not persuasive. It is suggested that Applicant provide an additional declaration which more clearly supports the claimed particle size range. For the above reasons, this rejection is maintained and made final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E Pulliam whose telephone number is 703-308-4710. The examiner can normally be reached on Mon-Thurs 7:30-5:00, Alternate Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone numbers for the

organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

A. Pulliam
Patent Examiner
Tech Center 1600/AU 1615
December 23, 2003

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600